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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,974	05/23/2001	Robert J. Gartside	1094-10	1412

7590

05/05/2003

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EXAMINER

NGUYEN, CAM N

ART UNIT

PAPER NUMBER

1754

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**Application No. 09/863,972Applicant(s) Robert J. Grant et al.

Examiner

Cam Nguyen

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Apr 7, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires three months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
see attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: None
- Claim(s) objected to: None
- Claim(s) rejected: 1-12, 22, and 23
- Claim(s) withdrawn from consideration: 13-21
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Application Serial No.: 09/863,974  
Group Art Unit: 1754

**Con't from Advisory Action Form**

***Response to Applicants' Arguments***

Applicants' amendment/response, filed on 4/7/03, has been fully considered, but not deemed persuasive for the following reasons.

Applicants urged, that "applicants show that the basic metal oxide double bond isomerization catalyst is materially different from the prior art catalyst materials and has different properties with respect to double-bond isomerization" (applicants' response page 3, second paragraph). This is not found persuasive because there is no catalyst properties being claimed in claims 1-9 & 22-23.

Applicants urged, that "the catalyst of the Sun patent is intended for skeletal isomerization and cannot be used in the claimed process of double bond isomerization" (applicants' response page 3, second paragraph). It appears that applicants' urging is directed to the intended use of the catalyst. The intended use of the claimed catalyst does not distinguish the claimed catalyst from the catalyst of the prior art, since it is well settled that terms merely setting forth intended use for, or property inherent in, an otherwise old composition do not differentiate the claimed composition from those disclosed in the prior art. See, *In re Pearson*, 181 USPQ 641. Also, "It is contrary to spirit and patent laws that patents be granted for old compositions of matter based on new uses of compositions where uses consist merely in employment of compositions; patentee is entitled to every use of which invention is susceptible, whether such use be known or unknown to him". See, *In re Thuau*, 57 USPQ 324.

Applicants further urged, that "Sun mentions nothing about the presence or absence of

activity-affecting amounts of water or carbon dioxide. Rather, the Sun catalyst is treated with a halogen source such as halogen acid or ammonium halide. Thus, the Sun catalyst is acidic. However, it is applicants' goal to eliminate acid sites to prevent fouling reactions which limit the onstream life of the catalyst... Therefore, the Sun catalyst would not be useful in the process claimed by applicants. Moreover, with applicants' process alkali metal oxides such as sodium oxide or potassium oxide can be incorporated into the catalyst as promoters whereas Sun considers alkali metal oxides to be poisons" (applicants' response page 3, second paragraph). This is noted, but not found persuasive because applicants' claimed catalyst is not being limited to include the alkali metal oxides only, but the alkaline earth metal oxides can also be included. Since Sun teaches a catalyst comprising at least one alkaline earth metal oxides (see Sun at col. 1, ln 41-50 & col. 3, ln 41-44), Sun teaches the claimed catalyst. Even though Sun does not mention the catalyst having substantially no activity-affecting amount of water or carbon dioxide as being claimed, it is considered the catalyst of Sun would possess the same properties because the catalyst of Sun contains the same catalytic components.

Applicants' urging regarding the combination of the Guth and the Dillion references is also noted, but not found persuasive for the same reasons as indicated in the Final office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cam Nguyen, whose telephone number is (703) 305-3923. The examiner can normally be reached on M-F from 8:30 am. to 6:00 pm, with alternative Monday off.

Nguyen/cnn *cnn*

April 30, 2003

*Cam Nguyen*  
Cam Nguyen

Patent Examiner